

### **Detailed Action**

1. In view of the appeal brief filed on 3-27-08, PROSECUTION IS HEREBY REOPENED. In view of the new grounds of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Peter M. Poon/

Supervisory Patent Examiner, Art Unit 3643

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

Application Publication No. 2002/0002375 to Legeai et al. in view of U.S. Patent No. 4,704,769 to Hanechak et al.

Referring to claims 1 and 26, discloses a removal instrument for making a hollow cavity comprising, an elongate section – at 14, having two straight parallel longitudinal sides – at 22, the elongate section forming a curved groove through the entire length of the elongate section and through the centerline between the longitudinal sides – see 16 in figures 1-3, an end section – at the forwardmost of 22 and – at 24,28, the end section extending from the elongate section – see figures 1-3 and tapering gradually from the longitudinal sides to a rounded point such that the curved groove continues through the end section – see figures 1-3, and a plurality of tines – at 32-38, emanating from a surface of the instrument – see figures 1-3, wherein at least one tine of the plurality of tines emanates from the end section – see at 32, wherein at least one tine of the plurality of tines – at 34-38, emanates from a location away from the sides and away from the end section – see figures 1-3, wherein the instrument has a width and a length – see figures 1-3 and paragraph [0049] where the width is 1.18 inches and the length of the spoon portion – at 14 is 3.15 inches and therefore the device of Legeai et al. has dimensions similar to those claimed. Legeai et al. further discloses the tine emanating from the end section – the forwardmost of 34-38, is directed away from the rounded point and towards the elongate section - see figures 1-2. Legeai et al. does not disclose the width as measured between the longitudinal sides is in the range between about one half inch and one inch and the overall length is in the range between 5

inches and 7 inches. Hanechak et al. does disclose the width is about one half and one inch and the length is between 5 and 7 inches - see column 3 lines 4-37. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. and add the width of about .5 to 1 inch and the length of about 5 to 7 inches of Hanechak et al., so as to allow for the device to be lightweight and easily held and handled by a user.

Referring to claim 4, Legeai et al. as modified by Hanechak et al. further discloses the at least one tine - at 34-38 of Legeai, that emanates from the end section includes a plurality of tines - see figures 1-2 of Legeai.

Referring to claim 5, Legeai et al. as modified by Hanechak et al. further discloses the plurality of tines emanate from the surface of the instrument at an angle in the range between about 15 degrees and about 45 degrees - see for example - at 34-38 in figures 1-2 of Legeai.

Referring to claim 6, Legeai et al. as modified by Hanechak et al. further discloses the rounded point on the end section is honed to a blade - at 24,32,33 - see figures 1-3 of Legeai .

Referring to claim 7, Legeai et al. as modified by Hanechak et al. further discloses the instrument is one integral piece - see figures 1-3 and paragraph [0048] of Legeai et al.

Referring to claim 22, Legeai et al. as modified by Hanechak et al. further discloses the groove comprises a substantially continuously curved groove - see at 16 in figures 1-3 of Legeai et al.

Referring to claim 23, Legeai et al. as modified by Hanechak et al. further discloses the sides - at 22, comprise straight parallel longitudinal edges of the elongate section - see figures 1-3 of Legeai et al., and wherein none of the plurality of tines - at 32-38 emanate from the edges - see figures 1-3 of Legeai et al.

Referring to claim 28, Legeai et al. as modified by Hanechak et al. further discloses all of the tines – at 34-38, of the plurality of tines emanate from the end section – see for example figures 1-2 of Legeai.

Claims 2 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legeai et al. as modified by Hanechak et al. as applied to claims 1 or 26 above, and further in view of U.S. Patent No. 1,997,339 to Olson.

Referring to claims 2 and 29, Legeai et al. as modified by Hanechak et al. does not disclose the instrument is made of steel. Olson does disclose the instrument is made of steel – see page 2 column 1 lines 60-69. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hanechak et al. and add the instrument made of steel of Olson, so as to allow for the device to be made durable for repeated use.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Legeai et al. as modified by Hanechak et al. as applied to claim 1 above, and further in view of U.S. Patent No. 2,533,445 to Finney.

Referring to claim 3, Legeai et al. as modified by Hanechak et al. does not disclose the instrument is made of stainless steel. Finney discloses the instrument is made of steel/stainless steel – see for example column 2 lines 8-14. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Hanechak et al. and add the instrument made of stainless steel of Finney, so as to allow for the device to be rust-resistant and more durable.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Legeai et al. as modified by Hanechak et al. as applied to claim 1 above. Legeai et al. as modified by Hanechak et al. does not disclose the body is the bait fish herring. However, it would have been obvious to

one of ordinary skill in the art to take the device of Legeai et al. as modified by Hill et al. and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Claims 9-12, 14, 16, 19, 24-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legeai et al. in view of Hanechak et al. and U.S. Patent No. 4,461,080 to Olson.

Referring to claims 9 and 27, Legeai et al. discloses a method including, inserting an entrails removal instrument into a body, the instrument comprising, an elongate body – at 14, having two straight parallel sides – at 22, the sides comprise straight parallel longitudinal edges of the body comprise straight parallel longitudinal edges of the body – see figures 1-3, the body forming a curved groove between the longitudinal sides – see at 16 in figures 1-3, an end section – at the forwardmost of 22 and – at 24,28, the end section extending from the elongate body and tapering to a rounded point – see for example figures 1-3, and a plurality of tines – at 32-38, emanating from a surface of the instrument, wherein at least one tine – at 32, of the plurality of tines emanates from the end section and wherein at least one tine – at 34-38, of the plurality of tines emanates from a location away from the sides and away from the end section – see for example figures 1-3, wherein the entrails removal instrument is adapted to fit into the body and form a hollow cavity when the instrument is inserted into the body, rotated and removed – see for example paragraphs [0051] thru [0062]. Legeai et al. further discloses at least one tine of the plurality of tines – at 34-38, emanates from the end section and towards the elongate body section – see the forwardmost of items 34-38. Legeai et al. further does not disclose cutting the head off a bait fish with a knife while leaving the body and tail intact, inserting the entrails

removal instrument into the fish body to a position forward of the tail and removing the viscera of the fish leaving the body and tail intact with a cavity. Hanechak et al. does disclose cutting the head off a bait fish with a knife while leaving the body and tail intact – see for example figures 1-9, inserting the entrails removal instrument into the fish body – see figure 9, to a position forward of the tail – see figure 9, and removing the viscera of the fish leaving the body and tail intact with a cavity – see for example figures 1-9 and columns 3-4. Therefore it would have been obvious to one of ordinary skill in the art to take the method of Legeai et al. and add the cutting the head off the fish and then creating a cavity in the fish by removing the viscera of the fish of Hanechak et al., so as to allow for the fish to be prepared for eating or further processing. Legeai et al. further does not disclose rotating the entrails removing instrument after inserting the entrails retaining instrument. Olson does disclose rotating the entrails removal instrument after inserting the entrails removal instrument - see column 4 lines 17-55. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. and add the rotating of the entrails removing instrument of Olson, so as to allow for the entrails of the animal to be securely grasped for easy removal from the animal.

Referring to clam 10, Legeai et al. as modified by Hanechak et al. and Olson further discloses the entrails remover is inserted at least 2 inches into the fish body – see for example figure 9 of Hanechak et al. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hanechak et al. and Olson and add the device inserted into the fish at least two inches of Hanechak et al., so as to allow for the device to grasp and hold a sufficient portion of the inside of the fish.

Referring to claim 11, Legeai et al. as modified by Hanechak et al. and Olson further discloses moving the entrails removal instrument in a lateral motion – see for example columns 3-4 of Hanechak et al. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hanechak et al. and Olson and add the lateral motion of the instrument of Hanechak et al., so as to allow for the device to grasp and hold a sufficient portion of the inside of the fish.

Referring to claim 12, Legeai et al. as modified by Hanechak et al. and Olson does not disclose the act of rotating includes rotating at least 360 degrees. However, it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hill et al. and Hanechak et al. and add the act of rotating the instrument 360 degrees, so as to ensure that the entire viscera component can be contacted and removed by the device.

Referring to claim 14, Legeai et al. as modified by Hanechak et al. and Olson does not disclose the body is the bait fish herring. However, it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hanechak et al. and Olson and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Referring to claim 24, Legeai et al. as modified by Hanechak et al. and Olson further discloses the groove comprises a substantially continuously curved groove – see at 16 in figures 1-3 of Legeai et al.

Referring to claim 25, Legeai et al. as modified by Hanechak et al. and Olson further discloses the sides – at 22, comprise straight parallel longitudinal edges of the elongate section –

see figures 1-3 of Legeai et al., and wherein none of the plurality of tines – at 32-38 emanate from the edges – see figures 1-3 of Legeai et al.

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legeai et al. as modified by Hanechak et al. and Olson as applied to claim 12 above, and further in view of U.S. Patent No. 6,698,133 to Fricke.

Referring to claim 13, Legeai et al. as modified by Hanechak et al. and Olson does not disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait. Fricke et al. does disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait – see for example figures 10-11. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hanechak et al. and Olson and add the inserting of the fishhook into the fish body of Fricke et al., so as to allow for the device to be used to catch fish.

Referring to claim 15, Legeai et al. as modified by Hanechak et al., Olson and Fricke et al. further discloses a plurality of fishing hooks – see for example column 7 lines 41-51 of Fricke et al. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Legeai et al. as modified by Hanechak et al. and Olson and add the inserting of the plurality of fishhooks into the fish body of Fricke et al., so as to allow for the device to be used to catch fish.

***Response to Arguments***



3. Applicant's arguments with respect to claims 1-15 and 22-29 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. PARSLEY whose telephone number is (571)272-6890. The examiner can normally be reached on Monday-Friday from 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J Parsley/  
Primary Examiner, Art Unit 3643